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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
YU, GINA C	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/069,975	PYKETT ET AL.	
	Examiner	Art Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 5-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 5-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of response filed on August 30, 2005. Claims 1, 2, 5-10 are pending. Claim rejections made under 35 U.S.C. § 103 (a) as indicated in the previous Office action dated March 30, 2005 are withdrawn in view of applicants' remarks. New rejections are made in view of further search and consideration.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Pat. No. 6855312 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a composition comprising a

mixture of three antioxidants selected from (a) ascorbic acid salts; (b) morus alba; (c) origarum vulgare; (d) panax ginseng; (e) rosmarinus officinalis; and (f) grape seed oil. While instant claim 1 requires "up to 3.5 % by weight" of the antioxidant mixture present in the composition, claim 3 of the '312 patent recites 0.005-10 % range. The selection of the antioxidants and the weight amount thereof as recited in the present application overlap with claimed invention in the '312 patent.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US 6524626 B2) .

Chen teaches topical compositions comprising ginseng (Panax Ginseng) berry juice and combined with other skin nutrients to provide essential vitamins and nutrients in a natural way. See abstract. Example 22 discloses a composition comprising 4% of ginseng extract, 2 % of grape seed extract, and 1 % of ascorbic acid. See also Examples 4, 6, 9, 13, 14, 20, 26, and 27, which contains at least three antioxidants recited in claim 1.

While the total amount of the antioxidants in Example 22 exceeds the recited 3.5 % in the instant claims, examiner notes that differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05 (II). The court in In re Aller held, "where the general conditions of a claim are disclosed in the prior art, it is not

inventive to discover the optimum or workable ranges by routine experimentation." See 220 F.2d 454, 456, 105 U.S.P.Q. 233, 235 (C.C.P.A. 1955). The court in In re Hoeschele also held, "the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages". See 406 F.2d 1403, 160 U.S.P.Q. 809 (C.C.P.A. 1969).

In this case, examiner takes the position that the claimed composition comprising "up to 3.5 %" of the amount of the three antioxidants is viewed prima facie obvious over the prior art composition and the teachings of the reference. It is viewed that the skilled artisan would have optimized the weight range of the ingredients by routine experimentation to find the workable weight amount of the active ingredients. The exemplified weight amount of the active ingredients does not in any way limit teaching of the reference. The reference teaches in col. 3, lines 8 – 11, "one gram of ginseng berry contains 1.4 times more antioxidant than [sic] 10 mg of Vitamin C". Thus it would have been obvious to a skilled artisan that even smaller amount of ginseng extracts than exemplified in reference would still provide stronger antioxidative effects than 1 % of vitamin C which is present in the example.

The claimed synergistic effect of the composition would have been also found in the exemplified prior art composition and the composition made as motivated by the teaching of the Chen reference. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or

obviousness has been established. See In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In this case, the only difference between the prior art and the claimed invention is that the prior art does not specifically mention the weight range "up to 3.5 %" as recited in the present claim. It is obvious that the claimed synergistic effect of the actives would be also present in the exemplified prior art composition and the composition made as motivated by the reference in lesser amount of the active ingredients because 1) there is no teaching in the reference which limits the amount of ginseng extracts to be used; 2) the reference exemplifies compositions having the claimed mixture of antioxidants within obvious weight range; and 3) the reference further teaches that even small amount of panax ginseng extract is far superior in providing antioxidative effect than vitamin C.

Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen as applied to claims 1, 5, and 6 above, and further in view of Gubernick (US 6066327).

Chen is discussed above. The reference teaches the motivation to make multi-vitamin skin care composition from natural sources. See col. 2, lines 4-42. While the reference illustrates formulas comprising ascorbic acid and generally teaches to combine vitamin C with the prior art invention, the reference fails to teach the specific vitamin C salt as recited in the present claims. The reference teaches to use ascorbic acid with ginseng extract in the composition as shown in Examples 9, 13, and 22. Example 9 discloses a composition comprising 5 % of ginseng extract, 2 % of grape seed extract, and 1 % of ascorbic acid. See also Examples 13, 20, and 26.

Gubernick discloses an antioxidant mixture for cosmetic composition, which comprises magnesium ascorbyl phosphate, and rosemary extract. See Example; col. 3, lines 39 – 40. The reference teaches using ascorbic acid or the derivative thereof, which indicates the art-recognized equivalency of the components. See col. 3, lines 41 – 50; Example. Magnesium ascorbyl phosphate is taught as the particularly preferred form of vitamin C. See Id.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Chen by substituting magnesium ascorbyl phosphate for ascorbic acid as motivated by Gubernick because 1) both references are analogous as they teach multi-vitamin and antioxidant cosmetic compositions; 2) Gubernick teaches the equivalency of ascorbic acid and magnesium ascorbyl phosphate and the preference for the latter; 3) and thus the skilled artisan would have had a reasonable expectation of successfully producing a skin care composition with enhanced or similar antioxidant property and multi-vitamin effects.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen and Gubernick as applied to claims 1, 2, and 5-7 above, and further in view of Maybeck (US 5164182).

Gubernick teaches that rosemary extract is a well-known antioxidant in cosmetic art, used in the amount of 0.0001-1 % by weight. See col. 4, lines 1-20. See instant claims 8-10 (d). The reference also teaches using 0.01-20 % by weight of magnesium ascorbyl phosphate. See col. 3, lines 41 – 50; Example. See instant claims 8(c) -10(c). In Chen, morus alba is used by 1 % by weight.

While it is viewed obvious to the skilled artisan to reduce the amount of the ingredient for cost-efficiency, the claimed invention requires 0.0005 –0.01 % of morus alba.

Maybeck teaches using mulberry extract as a skin-lightening and anti-inflammatory agent. See instant claim 7. The reference teaches using dry mulberry extract in the amount ranging from 0.005 -1 wt %, most preferably 0.005-0.1 wt %. See col. 4, line 16. See instant claims 8 (b) -10 (b).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Chen composition by adding mulberry extract in low amount as motivated by Maybeck because of the expectation of successfully producing an anti-aging cosmetic composition with skin lightening and anti-inflammatory effects in low amount.

Oath/Declaration

The declaration filed on December 20, 2004 was fully considered but is not persuasive to overcome the prima facie case of obviousness case of the present case. The declaration indicates that antioxidants produce "synergistic, protected effects" when used in combination; the antioxidant complex is more effective than tocopherol; a moisturizer comprising 1 % of the antioxidant complex produces reduction in lipid peroxidation caused by UV radiation; a skin care composition comprising 1 % of the antioxidant complex reduces skin aging. See Results. The declaration concludes that specific combinations of the antioxidants that are recited in the claims inhibit lipid peroxidation.

Examiner takes the position that one of ordinary skill in the art would have found the results obvious in view of the cited prior arts in this case. Chen already teaches using a mixture of the antioxidants claimed by applicants. The issue in this case is thus whether it would have been obvious to the skilled artisan to use the antioxidant mixture in a lower amount, as applicants have done. The declarant states on p. 4 of the declaration, "it is well known that the properties of anti-oxidants change when the amounts of anti-oxidants change; for example they may change into pro-oxidants which cause oxidation, the effect we are trying to reduce". This statement is not supported because there is no evidence in the record that lowering the antioxidant level would cause lipid peroxidation. While declarant also asserts, "any synergistic anti-oxidant effect found in the Examples of Chen could not be predicted to be reproduced with lesser amounts of the same ingredients". The declarant further states, "In my opinion, this disclosure would give the person skilled in the art no reason to reduce the workable quantities of the antioxidants used in these two particular examples in the expectation that a similar antioxidant effect would be obtained." However, it is noted that the courts have held that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See In re Allen. As indicated in the rejection above, the Chen reference already teaches the antioxidants that are claimed by applicants, without specific limitations to the weight amount of those active ingredients. Also in view of the teaching in Chen that even one tenth of ginseng extract provides more antioxidative effects than conventionally known antioxidant, vitamin C, the skilled artisan would have been

motivated to use smaller amounts of ginseng extract than exemplified in the disclosure and still expect the superior antioxidant effect.

It is noted that the scope of the claims is not commensurate with applicants' disclosure or the data in the declaration. The weight range of the antioxidants read on zero since the term "up to" includes zero as a lower limit. See In re Mochel, 470 F.2d 638, 176 USPQ 194 (CCPA 1974).

Response to Arguments

Applicant's arguments filed on August 30, 2005 have been fully considered but are moot in view of the new grounds of rejection. See also Oath/Declaration.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER